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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,303	05/24/1999	BRUCE A. DONOHO	DONO-7	8945

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EXAMINER

PALO, FRANCIS T

ART UNIT PAPER NUMBER

3644

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/317,303

Applicant(s)

DONOHO, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 and 20-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 6/2/06 have been fully considered but they are not persuasive.

The argument that Richardson as modified by Shaw could never be manufactured as a single continuous piece is not persuasive, and is interpreted as a response to a product by process limitation within an apparatus claim; however, it is maintained, that since Shaw teaches a five-rayed plastic construction, it would be obvious to modify the Richardson four-rayed plastic construction to include a fifth ray and to produce such as an injection molded single continuous piece just as taught by Richardson with the four-rayed configuration; not withstanding Richardson contemplating a fifth angle or ray by the recitation, 'at least four different angles to the base element'.

The arguments directed to the submitted structural deficiencies in Richardson are addressed in the independent claim rejections to follow.

Furthermore, as the rejections of the dependent claims have not been traversed by applicant, those rejections are maintained unchanged herein this final office action, the focus of the arguments being directed to the amended independent claims 10 and 31.

**Claims 10-18 and 20-35** remain for prosecution on the merits.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10-12, 16-18, 20 and 22-34** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** (GB 2344269A) 1998,  
in view of **Shaw** (US 3,282,000) 1963.

Regarding **independent claim-10** and dependent **claim-11**:

Richardson discusses on page-4 and depicts in the figures a bird deterrent for mounting on a surface comprising an elongated ('sinuous') and sectioned (16, 17) rail of plastic (15) wherein, the base of each of the prongs is provided by a projection that extends laterally from the main path of the rail of plastic (15); this lateral teaching is read as analogous to the 'prongs extending laterally' as claimed, defined in the applicant's disclosure and as argued.

Richardson further depicts alternating pairs of prongs (11,12) and (13,14) in figure-3 which, when compared to applicant's invention as depicted in figure-3, comprising alternating pairs of prongs (26,28) and (24,30) are readable on the instant limitation, 'alternating between a higher position and lower position', as claimed;

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specifically, in the Richardson pair of prongs (11,12), prong (12) is higher than prong (11) and in the successive pair (13,14), prong (13) is higher than (14) or (11), just as depicted in figure-3 of the instant invention, wherein (28) is higher than (26) and (24) is higher than (30).

Richardson by contemplating more than four angles to the base element provides the motivation for a fifth angle, such as claimed by applicant's 'upwardly extending intermediate prongs disposed', as claimed and as taught by **Shaw '000**.

As previously submitted and maintained, Shaw '000 teaches a five-rayed plastic construction having upwardly extending intermediate prongs (figure-1, element-20), as claimed, wherein the five-rayed plastic prongs of Shaw are interchangeable to the plastic base.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided Richardson with an intermediate prong (20) as taught by Shaw, as Richardson contemplates more than four angles to the base element.

Further, it is maintained that the modification to Richardson does not render Richardson incapable of maintaining construction as a continuous molded piece, as claimed and taught by Richardson.

Regarding **claim-12**:

The discussion above regarding claim-11 is relied upon.

Richardson as modified by Shaw is readable on the instant claim, as Richardson teaches angles less than 90°.

Regarding **claims 16 and 17**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a base readable as a rail and side projections extending from the base (rail) continuous with the rail, as claimed.

Regarding **claim-18**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches prongs extending upwards from side projections extending laterally from the main path of the strip-like base element at line-15 (thereabout) on page-3.

Regarding **claims 20 and 22**:

The discussion above regarding claim-10 is relied upon.

Prongs as claimed, are readily apparent from figure-1 of Richardson.

Regarding **claims 23 and 24**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches (depicts) a base (read as a rail) having a flat bottom surface and a trough; the trough located on the upper surface of the base.

Note: it is not clear from the claim language which side the trough is located.

Regarding **claim-25**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts in figure-1 structure(s) readable on a ridge, as claimed.

Regarding **claim-26**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a tapered spike readable as having first and second portions having a round cross-section; Richardson as modified by Shaw is readable therefore thereon the instant claim.

Regarding **claim-27**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a five-fanned projection as claimed.

Regarding **claim-28**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a normal extending prong as claimed.

Regarding **claim-29**:

The discussion above regarding claim-10 is relied upon.

As discussed above in the rejection of claim-28, Richardson as modified by Shaw renders a normal extending prong as claimed, and while Richardson teaches ridges running along the upper surface of the rail (base), Richardson is silent as to upwardly extending prongs being normal to a ridge running along an upper surface of the rail. Shaw teaches normal prong extension from a ridge as depicted in figures 4 and 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include an upwardly extending intermediate prong as taught by Shaw and as claimed, for the known advantages of that feature.

Regarding **claim-30**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts cutting notches on the underside of the base (rail) as claimed.



Regarding **independent claim-31**:

The discussion above regarding independent claim-10 is relied upon as encompassing the broad instant claim.

Regarding **independent claim-31**:

The discussion above regarding independent claim-10 is relied upon as encompassing the instant claim.

Regarding **claims 32-34**:

The discussion above regarding claim-31 is relied upon.

The structure and orientation of the prongs as claimed are readily apparent from the depictions of Richardson.

**Claims 13-15** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** and **Shaw**,  
as applied to claims 10 and 11 above,  
and further in view of **Burnside** (US 2,777,171) 1951.

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Regarding **claims 13-15**:

The discussions above regarding claims 10 and 11 are relied upon.

Richardson teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36) and therefore on the order of 22° difference between the prongs; Richardson does not teach about 30 and 70° and a difference of about 40°, as claimed.

Richardson in column-4 at lines 18 and 24 (thereabout) recites, "in this example the angles"; the language is read as motivation for other angles to be utilized other than discussed and depicted in the teaching.

Burnside teaches prongs (11-15) "bent upwards at different angles..", (column-3, lines 22-23) and prongs (21-25), "bent at somewhat different angles than those of figure-1", (column-3, lines 28-29).

The Examiner submits that Burnside teaches the angles claimed in the instant claims, or at least the obviousness for that capability, that is; prong angles of about 30 and 70° are apparent from the figures 1 and 2 of Burnside.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and depicted and inferred by Burnside, for the known advantages of that feature.

**Claim-21** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Richardson** and **Shaw** as applied to claim-10 above, and further in view of **Peles** (US 2,938,243) 1953.

Regarding **claim-21**:

The discussion above regarding claim-10 is relied upon.

Richardson is silent as to prong cross-section configuration except for the depictions, which resemble tapered prongs having circular cross-sections.

Peles '243 teaches a prong readable on a cross-shaped cross-section (at a minimum a partial cross-shaped cross-section) to provide rigidity to the prongs (column-2, lines 20-22).

As it has been held that mere duplication of essential working parts of a device requires only routine skill in the art (*In re Japikse*, 86 USPQ 70), it would have been obvious to reproduce the ridge (21) on the other side of the Peles prong for the known advantage of that feature, which would enable the full cross-shaped cross section as claimed.

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong cross-section as claimed as taught by Peles, for the known advantage of that feature as taught by Peles.

**Claim-35** is rejected under 35 U.S.C. 103(a),  
as being unpatentable over Richardson in view of Burnside.

Regarding **new independent claim-35**:

Richardson as discussed above in the rejection of claim-10 teaches an integrally molded deterrent as claimed, and teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36); Richardson does not specifically recite no more than 70°, as claimed.

Burnside as discussed above in the rejection of claims 13-15 provides the teaching for various angles, which would encompass the claimed 70° prong angle.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and as depicted and inferred by Burnside, for the known advantages of that feature.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Francis T. Palo*

Francis T. Palo  
Primary Examiner  
Art Unit 3644